UNITED STATES PATENT AND TRADEMARK OFFICE

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732

EXAMINER
HUYNH, CONG LAC T

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PTOL-90A (Rev. 04/07)

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/614,584
Filing Date: July 07, 2003
Appellant(s): KRAUSZ ET AL.

MAILED

AUG 0 8 2007

Technology Center 2100

Gary R. Jarosik
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/12/07 appealing from the Office action

mailed 7/21/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 20030074271 | VISWANATH et al. | 4-2003 |
| 20050273772 | MATSAKIS et al. | 12-2005 |

Peat et al., Introducing XML/EDI ..." the e-Business Framework", August 1997, pages 1-
19.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A.   Claims 14-16, 18, 20-21 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Viswanath et al. (US Pat App Pub No 2003/0074271, 4/17/03, filed

10/17/01) in view of Matsakis et al. (US Pat App Pub No 2005/0273772, 12/8/05, priority

12/21/99) and Peat et al., *Introducing XML/EDI..."the e-Business framework"*, August

1997, IDS.

Regarding independent claim 14, Viswanath discloses:

-   using a graphical user interface to create a file including tags (figure 2, [0049]-

    [0058]: via the interface, XML files with tags are created for business purpose in

    purchasing system that allows users to perform typical customization)

-   including XML tags for selecting data for inclusion in the purchase order (([0016]-

    [0017],[0019]) and specifying a layout for the purchase order including the

    selected data ([0018], [0021], [0084]-[0086])

-   accessing a database of a service provider to collect data according to the tags

    for using the collected data and generating a purchase output file ([0016]-[0021])

-   providing the purchase output file to an output device which uses the purchase

    output file to generate the purchase order where the data for the purchase order

is fetched in response to the user's request and the format is formed suitable for

delivery in response to the particular purchase order ([0018], [0021])

Viswanath does not disclose that the xml document is an invoice.

Matsakis discloses using XML format for business documents such as invoices and

purchase orders ([0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Matsakis into Viswanath for generating an invoice using

the same method as in Viswanath since invoices or purchase orders are business

documents including specific data related to invoices or purchase orders. Thus, by

analogy, an invoice can be generated using Viswanath method with XML tags and

specific data related to an invoice.

Viswanath and Matsakis do not disclose that the tags used for the purchase order or the

invoice are the IML tags of the Invoice Markup Language.

Peat addresses that it is surprisingly simple that one can define one's own markup

language with XML (page 10).

Therefore, it would have been obvious to an ordinary skill at the time of the invention

was made to have combined Peat into Matsakis and Viswanath for the following reason.

Matsakis discloses using XML for encoding business documents such as invoices and

purchase orders providing the advantage to incorporate into Viswanath method for

generating an invoice using XML with specific data relating to invoices as desired

instead of data relating to purchase orders.

Further, since defining a particular markup language based on XML for a specific purpose is possible according to Peat, it appears that XML, when applied for generating an invoice, would produce an invoice markup language with specific tags relating to invoice characteristics.

Regarding claim 15, which is dependent on claim 14, Viswanath disclose that the purchase order output file comprises an HTML file [0024].

Matsakis discloses using XML format for business documents such as invoices and purchase orders ([0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Matsakis into Viswanath for outputting an invoice file using the same method as in Viswanath since invoices or purchase orders are business documents including specific data related to invoices or purchase orders. Thus, by analogy, an invoice can be generated using Viswanath method with XML tags and specific data related to an invoice.

Regarding claim 16, which is dependent on claim 15, Viswanath discloses transmitting the output file via a network to the output device ([0012], [0017]).

Regarding claim 18, which is dependent on claim 16, Viswanath discloses that the output device comprises a personal computer ([0014], [0015], [0060]).

Claims 20-21 are for a system for performing method claims 14 and 15, and are

rejected under the same rationale.

B.   Claim 17 remains rejected under 35 U.S.C. 103(a) as being unpatentable over

Viswanath in view of Matsakis and Peat as applied in claim 16 above, and further in

view of Emmett et al. (US Pat App Pub No 2002/0129006 A1, 9/12/02, filed 2/14/02,

priority 2/16/01).

Regarding claim 17, which is dependent on claim 16, Viswanath, Matsakis, and Peat do

not disclose that the output device comprises a hand-held processing device.

Emmett discloses that handheld devices including Personal Digital Assistants (PDAs)

and cellular telephones offer connectivity to the Internet and permit access to

documents available over the Internet ([0005]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Emmett into Viswanath, Matsakis, and Peat since Emmett

discloses that a handheld device can access to a document available on the Internet

providing the advantage to incorporate into Viswanath, Matsakis, and Peat for having a

handheld device as a convenient output device, since a user can carry it with him or her

anywhere, for accessing an online invoice, a form of Internet document.

C.   Claims 19 and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable

over Viswanath, Matsakis, and Peat as applied in claim 16 above, and further in view of

Scolini et al. (US Pat App Pub No 2003/0233321 A1, 12/18/03, filed 10/30/02, priority

11/30/01).

Regarding claim 19, which is dependent on claim 14, Viswanath, Matsakis, and Peat

do not disclose that the invoice output file comprises a printer-control language file.

Scolini discloses that the invoice or customer bill is converted into AFP format as the

output file ([0842], [0980]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

was made to have combined Scolini into Viswanath, Matsakis, and Peat since the AFP

form, which is a printer-control language file, of the invoice in Scolini provides the

advantage to incorporate into the invoice in Viswanath, Matsakis, and Peat for rapidly

printing the invoice document at a printer site.

Claim 22 is for a system for performing method claim 19, and is rejected under the

same rationale.

(10) Response to Argument

Appellant argues that Viswanath fails to disclose, teach or suggest generating an

invoice and an invoice markup language (IML) as claimed. Appellant further argue

that "More particularly, each of Viswanath, Matsakis, and Peat fails to disclose, teach or

suggest providing a graphical user interface tool to create a file (whether IML or

otherwise) that includes a first set of tags (whether IML or otherwise) defined by a

document type definition that are used to select data for inclusion in a document

(whether an invoice or otherwise) and a second set of tags (whether IML of otherwise)

defined by the document type definition that are used to specify both a page style for

the document and how to display the selected data within the document" (Brief, page 5).

Examiner agrees that Viswanath fails to disclose or teach generating an invoice and an

invoice markup language (IML) as claimed. However, as addressed in the final action,

Viswanath discloses using XML for generating a purchase order ([0016]- [0019]), where

business documents such as purchase order and invoice are generated using XML

according to Matsakis ([0012]). It is also noted that it was well known that the

purchasing process where the purchase order is generated for buying on the Internet as

in Viswanath is carried out via a user graphical interface. Peat discloses that one can

define their own markup language with XML (page 10). Therefore, it would have been

obvious to an ordinary skill in the art at the time of the invention was made to combine

Peat into Matsakis and Viswanath for defining an invoice markup language IML for

generating an invoice, actually for selecting data to be included in the invoice as well as

displaying the selected data within the invoice for the following reason. Generating an

invoice with XML would be carried out the same way as for generating a purchase order

in XML as in Viswanath since both purchase order or invoice are business documents

created in XML. Also, using XML to define a markup language such as an invoice

markup language for generating an invoice with specific data selected to be included in

the invoice is suggested according to Peat regarding using XML to define a markup

language for a specific purpose.

In addition, it is noted that Matsakis shows that XML tags are defined by a document

type definition ([0122], [0127], [0371]). Peat also mentions that XML tags are defined by

a document type definition (page 10). Therefore, it would have been obvious to an

ordinary skill in the art at the time of the invention was made to combine Viswanath,

Matsakis, and Peat for the feature argued above.

Appellant also argue that no cited reference discloses, teaches, or suggests the claimed

graphical user interface tool that is used to create a file that includes both a first set of

tags defined by a document type definition that are used to select data for inclusion in a

document and a second set of tags defined by the document type definition that are

used to specify both a page style for a document and how to display the selected data

within the document (brief, page 7).

Examiner respectfully disagrees.

Viswanath discloses *creating one file* with XML tags for selecting data to be included in

a purchase order and for a style of the layout of the purchase order ([0054]-[0058]). In

addition, since Viswanath discloses using XML tags for selecting data to be included in

a purchase order as well displaying of the purchase order, Viswanath, thus, implies that

there are two different sets of tags in one file to control selecting data for the purchase

order and to control displaying of the selected data for the purchase order.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

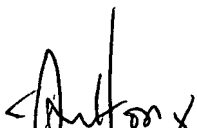For the above reasons, it is believed that the rejections should be sustained.
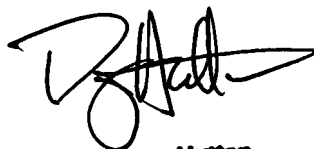
Respectfully submitted,

Cong-Lac Huynh
Primary Examiner
8/2/07

Conferees:

Stephen Hong

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Doug Hutton

Doug Hutton
Primary Examiner
Technology Center 2100